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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------|-------------|----------------------|---------------------|------------------|
| 10/666,987 | 09/19/2003 | Yuji Horie | NMCIP045 | 6654 |
| 22434 | 7590 | 02/24/2006 | EXAMINER | |
| BEYER WEAVER & THOMAS LLP | | | ELEY, TIMOTHY V | |
| P.O. BOX 70250 | | | ART UNIT | |
| OAKLAND, CA 94612-0250 | | | PAPER NUMBER | |

3724

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/666,987 | Applicant(s) HORIE ET AL. | |
| | Examiner Timothy V. Eley | Art Unit 3724 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-7 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of claims 1, and 3-7 is withdrawn in view of further consideration of the reference to Mednick(3,976,525). Rejections based on Mednick follow.

- Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1,3, and 5 are rejected under 35 U.S. C. 102(b) as being anticipated by Mednick(3,976,525).

- Mednick discloses a polishing cloth comprising a base material(33) and a surface layer stacked over the base material, the surface layer comprising a foamed layer(11) and a non-foamed layer(13), the foamed layer including air bubble cells(as clearly show in figures 2 and 3), the non-foamed layer having an externally exposed surface where in linear cuts are formed(notice linear surfaces on the needle punch shown in figure 5), the

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linear cuts reaching the air bubble cells whereby the air bubble cells communicate to the exterior through the linear cuts. See column 3, lines 24-35.

- Regarding claim 3, the base material comprises resin materials. See column 4, line 10.
- Regarding claim 5, the surface layer comprises foamed polyurethane resin. See column 4, lines 62-64.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 4,6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mednick.

- Mednick is explained above.
- Regarding claim 4, Mednick does not disclose the exact type of resin material for the base material as recited by applicant. However, the exact type of resin used would have been an obvious matter of design choice to one having ordinary skill in the art at the time the invention was made since clearly any appropriate base material may be used which adequately supports the surface layer and since applicant has not disclosed that the exact

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material of the base provides any stated advantage over the prior art.

- Regarding claims 6 and 7, the surface layer of Mednick has an unevenness produced by a needling process. See figures 2 and 3. Mednick does not disclose that the unevenness is produced by a gravure process or embossing as recited by applicant. However, exactly how the unevenness is produced would have been an obvious matter of choice and structural design to one having ordinary skill in the art at the time the invention was made since applicant has not disclosed that exactly how the unevenness is produced provides any stated advantage over the prior art.

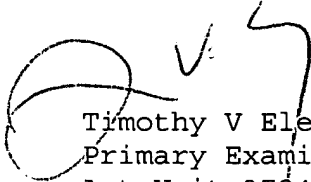
Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy V. Eley whose telephone number is 571-272-4506. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Timothy V Eley
Primary Examiner
Art Unit 3724

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